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Paper No. 4

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In re Application of  
Kozoriz  
Application No. 09/654,964  
Filed: September 5, 2000  
For: SUPER CONDUCTIVE BEARING

OFFICE OF PETITIONS  
DECISION DISMISSING  
PETITION

This is a decision on the petition under 37 CFR 1.47(b), filed on September 5, 2000, requesting that Global Trading & Technology, Inc. ("Global") be allowed to make the application on behalf of and as agent for the sole inventor who allegedly refuses to execute the application.

The petition is **DISMISSED**.

The sole inventor for the claimed invention in this application is Vasyly V. Kozoriz ("Kozoriz"), who allegedly has entered into an "Intellectual Property Rights and Invention Development Contract" ("Contract")<sup>1</sup> with Global, under which "the invention and all the proprietary rights thereto have been duly assigned in the entirety to Global."<sup>2</sup>

Under 37 CFR 1.47(b), if the sole inventor, as alleged in the instant case, refuses to execute an application for patent, a person<sup>3</sup> with demonstrated proprietary interest<sup>4</sup> may make application on behalf of and as agent for this inventor.<sup>5</sup> Specifically, with respect to the instant case, the 37 CFR 1.47(b) applicant, i.e., Global, must:

- (1) make out a *prima facie* case that Kozoriz has assigned, or agreed in writing to assign the invention, which is the subject matter of this application, to Global; or that Global otherwise has sufficient proprietary interest in this invention for

<sup>1</sup> Such a "contract" was presented to the PTO with the 9/5/00 application as an "assignment" of rights to this application and the patent ultimately granted. This document was recorded on 9/5/00.

<sup>2</sup> Petition, page 1, paragraph 2, Statement, 2nd to the last sentence.

<sup>3</sup> A "person" can be a natural person or a legal entity such as a corporation; see MPEP section 409.03(b) (Aug. 2001).

<sup>4</sup> See MPEP sections 409.03(b), (f) (Aug. 2001) (E.g., a "person" to whom the inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the patent application to justify the filing of such an application.).

<sup>5</sup> This "person" then becomes the so-called "37 CFR 1.47(b) applicant."<sup>6</sup>

**justifying this application:<sup>6</sup>**

- (a) If the application has been assigned to Global, a **copy of the assignment**, in addition to a statement under 37 CFR 3.73(b) by Global, must be submitted, and **must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to Global**;<sup>7</sup>
  - (b) If, instead, Kozoriz has agreed in writing to assign the invention, which is the subject matter of this application, to Global, a copy of such an agreement should be submitted;<sup>8</sup>
  - (c) A proprietary interest in the invention, which is the subject matter of this application, if obtained by Global through means other than (a) or (b), may be demonstrated by an **appropriate legal memorandum** to the effect that a court of competent jurisdiction would be the weight of authority in that jurisdiction to award title of this invention to Global;<sup>9</sup>
- (2) properly make the oath;<sup>10</sup>
  - (3) state the relationship between Global and Kozoriz, as required by 37 CFR 1.64;<sup>11</sup>
  - (4) submit **proof** that:
    - (i) a *bona fide* attempt was made by Global to present an **entire** copy of the application (specification including claims, drawings, and

<sup>6</sup> MPEP sections 409.03(b)(E), 409.03(f) (Aug. 2001).

<sup>7</sup> MPEP section 409.03(f) (Aug. 2001).

<sup>8</sup> Typically an employment agreement where the employee (nonsigning inventor) agrees to assign to his employer (37 CFR 1.47(b) applicant) all inventions made during employment; see MPEP section 409.03(f) (Aug. 2001). Such an agreement must be accompanied by a statement of a person having firsthand knowledge of the pertinent facts, establishing that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant. *Id.*

<sup>9</sup> E.g., an **affidavit or declaration** by the person having firsthand knowledge of the facts supporting the conclusion that a court would award title of this invention to Global. Such a person may be an attorney at law familiar with the law of the jurisdiction involved (federal, state, foreign). See MPEP section 409.03(f) (Aug. 2001).

<sup>10</sup> See MPEP sections 409.03(b)(A), 409.03(f) (Aug. 2001) (I.e., an oath in accordance with 37 CFR 1.63 and 1.64, and signed by an officer of Global, if Global is properly proven to be the party with sufficient proprietary interest in this invention to justify this application.).

<sup>11</sup> MPEP section 409.03(b)(B) (Aug. 2001).

oath or declaration) to Kozoriz for signature;<sup>12</sup> and

- (ii) Kozoriz refused to sign the application;<sup>13</sup>
- (5) state Kozoriz's last known address;<sup>14</sup> and
- (6) prove that the filing of this application under 37 CFR 1.47(b) is necessary to preserve the rights of the parties, or to prevent irreparable damages.<sup>15</sup>

The "Contract" presented by Global to the PTO on September 5, 2000 for recordation, which was subsequently recorded by the PTO, lacks item (1) above in that, it does not include any information for the Office to conclude that it is an **assignment that clearly indicates that the invention claimed in this application was assigned to Global.**<sup>16</sup>

<sup>12</sup> MPEP section 409.03(d) (Aug. 2001).

<sup>13</sup> MPEP section 409.03(b)(C) (Aug. 2001).

<sup>14</sup> MPEP sections 409.03(b)(D), 409.03(e) (Aug. 2001).

<sup>15</sup> MPEP sections 409.03(b)(F), 409.03(g) (Aug. 2001) (Such a showing can be a statement that a filing date is necessary to preserve the rights of the parties or to prevent irreparable damages).

<sup>16</sup> As stated in 37 CFR 3.54, the recording of this "Contract" in the PTO is not a determination by the PTO of the validity of this "Contract," or the effect this "Contract" has on the title to this application or the ultimate patent granted.

In addition, the document recorded at the PTO on 9/5/00 is merely a general contract which:

- appears to refer to future transfer of future interests; see clause 2 of Contract ("[Kozoriz] shall execute an assignment of Patent Form which shall be recorded in the U.S. Patent Office at such time the patent(s) are issued.");
- does not refer specifically to this application, or the invention that is the subject matter of this application;
- contains, on the last page:
  - a "Special Power of Attorney by Owner and Seller of Intellectual Property" appointing Walter G. Reiner, owner of Global, as "true and lawful attorney for Vasyl' Kozoriz";
  - If this Power of Attorney is accepted, Water G. Reiner would manage certain of Kozoriz's intellectual property, and consequently cannot possibly be also the assignee of the same intellectual property;
  - This Power of Attorney refers to "... eventual patenting" of "Inelastic Magnetic Bearing" and "Manufacture for Acceleration or Braking or both and Method of Use," neither of which bears ready resemblance to the invention claimed in the application at issue;
- is not executed.

Given that Global, being a 37CFR 1.47(b) applicant, **fails to meet even the threshold requirement specified in item (1) above**, the instant petition is thus dismissed and the declaration signed by Global on behalf of and as agent for Kozoriz is not accepted.

To prevent abandonment of this application,<sup>17</sup> either of the following **must** be filed within **TWO (2) MONTHS** from the mailing date of this decision:<sup>18</sup>

- An oath or declaration executed by Kozoriz in accordance with 37 CFR 1.63;<sup>19</sup>
- A renewed petition under 37 CFR 1.47(b).<sup>20</sup> Such renewed petition (no fee), to be grantable, must include all elements specified in items (1)-(6) above.

This 2-month period may be extended under 37 CFR 1.136(a).

Further correspondence with respect to this matter should be addressed as follows:

- By mail:      Assistant Commissioner for Patents  
                  Box DAC  
                  Washington, D.C. 20231
- By fax:        (703)308-6916  
                  Attn: Office of Petitions
- By hand:      Crystal Plaza Four, Suite CP4-3C23  
                  2201 South Clark Place  
                  Arlington, VA 22202

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<sup>17</sup> See 37 CFR 1.53(f) (If an application which has been accorded a filing date . . . does not include an oath or declaration by the applicant pursuant to §1.63 . . . , applicant will be notified and given a period of time within which to . . . file an oath or declaration . . . and pay the surcharge required by §1.16(e) to avoid abandonment).

<sup>18</sup> See 37 CFR 1.181(f).

<sup>19</sup> To be filed directly with the Initial Patent Examination Division, PTO, along with the \$130 surcharge, without any petition.

<sup>20</sup> To be filed as instructed below.

Telephone inquiries concerning this matter may be directed to Petitions Attorney RC Tang at (703) 308-0763.



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Office of the Deputy Commissioner  
for Patent Examination Policy